

Applicant : Marck Kwiatkowski
Serial No. : 10/071,585
Filed : February 8, 2002
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Attorney's Docket No.: 11989-008001 / Q006US1

REMARKS

Claims 1-29 and 32-35 are pending. Claims 4, 5, 10-13, 18, 20-23, 29, 32, and 33 stand withdrawn, and claims 1-3, 6-9, 14-17, 19, 24-28, 34, and 35 stand rejected. Claims 1 and 27 are amended herein such that step b) recites that the at least one bifunctional oligonucleotide and at least one non-bifunctional oligonucleotide to the separation medium. Claim 27 also is amended herein such that steps c) and e) recite eluting non-bifunctional oligonucleotides, if any, lacking the first (step c) or second (step e) separation tag. Finally, claim 34 is amended herein to recite "the oligonucleotide." Support for these amendments can be found in Applicant's specification. *See*, for example, page 11, lines 23-26, which disclose that a mixture of bifunctional and non-bifunctional oligonucleotides can be contacted with a separation medium that retains bifunctional oligonucleotides as well as non-bifunctional oligonucleotides. Thus, no new matter has been added.

In light of these amendments and the following remarks, Applicant respectfully requests reconsideration and allowance of claims 1-3, 6-9, 14-17, 24-28, 34, and 35. Applicant also respectfully requests rejoinder and allowance of claims 4-5, 10-13, 18, 20-23, 29, and 32-33.

Rejections under 35 U.S.C. § 112

The Examiner rejected claims 1-3, 6-9, 14-17, 19, 24-28, 34, and 35 under 35 U.S.C. § 112, second paragraph, as being indefinite. With regard to claims 1 and 27, the Examiner alleged that since the claims do not require that non-bifunctional oligonucleotides adhere to the separation medium, it is unclear how to elute the non-bifunctional oligonucleotides as recited in step c) of claim 1 and steps c) and e) of claim 27. The Examiner further wondered how claim 27 can perform steps c) and e) if step a) has only one non-bifunctional oligonucleotide. With regard to claim 26, the Examiner alleged that since step d) requires only cleaving either the first separation tag or the second separation tag, it is unclear how to elute an oligonucleotide lacking the first separation tag and an oligonucleotide lacking the second separation tag at the same time "as recited in step e) of the claim." With regard to claim 34, the Examiner alleged that there is insufficient antecedent basis for "said oligonucleotide" in step g) because step f) does not contain the term "oligonucleotide."

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To further prosecution, Applicant has amended step b) of claims 1 and 27 to recite that at least one non-bifunctional oligonucleotide binds to the separation medium. Thus, it is clear how a non-bifunctional oligonucleotide can be eluted from the separation medium in step c) of claims 1 and 27, and these claims are definite. Claim 27 also has been amended to recite that non-bifunctional nucleotides, if any, are eluted in steps c) and e). Thus, it is clear that claim 27 can include both steps c) and e). In addition, Applicant has amended claim 34 herein to recite "the" oligonucleotide. Thus, the rejection based on lack of antecedent basis is moot.

With regard to claim 26, Applicant respectfully submits that step e) does not recite or require eluting two separate non-bifunctional oligonucleotides, one lacking the first separation tag and the other lacking the second separation tag. Rather, the oligonucleotides eluted in step e) lack both the first and second separation tags. The eluted non-bifunctional oligonucleotides originally had one separation tag, and were adhered to the separation medium as recited in step b) of amended claim 1. Cleavage of the separation tag in step d) of claim 26 results in a non-bifunctional oligonucleotide that lacks both of the separation tags, and thus it can be eluted from the column in step e) of claim 26. Applicant respectfully submits that claim 26 is definite, particularly in light of the amendment to claim 1.

In light of the above, Applicant respectfully requests withdrawal of the rejection of claims 1-3, 6-9, 14-17, 19, 24-28, 34, and 35 under 35 U.S.C. § 112, second paragraph.

Request for rejoinder of withdrawn claims

In the Response to Restriction Requirement mailed August 6, 2004, Applicant made several species elections that resulted in claims being withdrawn. Given the allowability of claims cited by the Examiner as being generic to the distinct species, Applicant respectfully requests consideration of claims to additional species as provided by 37 C.F.R. § 1.141. (*See*, MPEP § 809.02(a). *See, also*, MPEP § 818.03(d), which states that if the Office allows a linking claim, it is bound to withdraw the requirement and to act on all linked inventions.) Thus, Applicant requests rejoinder of the withdrawn claims as follows:

First, the Examiner stated that claim 1 is generic to claims 3-6. Claims 4 and 5 were withdrawn. Since claims 4 and 5 depend directly or indirectly from claim 1, which has been allowed, Applicant respectfully requests rejoinder of claims 4 and 5.

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Second, the Examiner stated that claim 1 is generic to claims 8-13. Claims 10-13 were withdrawn. Since claims 10-13 depend indirectly from claim 1, which has been allowed, Applicant respectfully requests rejoinder of claims 10-13.

Third, the Examiner stated that claim 1 is generic to claims 17-23. Claims 18 and 20-23 were withdrawn. Since claims 20-23 depend directly or indirectly from claim 1, which has been allowed, Applicant respectfully requests rejoinder of claims 18 and 20-23.

Fourth, the Examiner stated that claim 27 is generic to claims 28-29. Claim 29 was withdrawn. Since claim 29 depends directly from claim 27, which appears to have been allowed, Applicant respectfully requests rejoinder of claim 29.

Finally, the Examiner stated that claim 1 is generic to claims 16, 32, and 33. Claims 32 and 33 were withdrawn. Since claims 32 and 33 depend directly from claim 1, which has been allowed, Applicant respectfully requests rejoinder of claims 32 and 33.

CONCLUSION

Applicant submits that claims 1-3, 6-9, 14-17, 19, 24-28, and 34-35 are in condition for allowance, which action is respectfully requested. Applicant also requests rejoinder and allowance of claims 4, 5, 10-13, 18, 20-23, 29, and 32-33. The Examiner is invited to telephone the undersigned agent if such would further prosecution.

Please charge \$60 for the Petition for Extension of Time fee, and apply any other charges or credits, to deposit account 06-1050.

Respectfully submitted,

Date: June 1, 2006

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